

U.S. Patent Application Serial No. **09/417,705**
Amendment filed April 26, 2006
Reply to OA dated January 26, 2006

REMARKS:

Claims 16-23 are currently pending. No claims have been amended herein.

Claims 16, 17, and 21-23 stand rejected under USC 103(a) as obvious over USP 6,628,328 (**Yokouchi**) in view of USP 5,835,164 (**Kanai**).

Applicant respectfully traverses this rejection, for the following reasons.

Obviousness is based on several underlying issues of fact, namely: (1) the scope and content of the prior art; (2) the level of skill of a person of ordinary skill in the art; (3) the differences between the claimed invention and the teachings of the prior art; and (4) the extent of any objective indicia of nonobviousness. When obviousness is based on the teachings of multiple prior art references, the Examiner must also establish some suggestion, teaching, or motivation that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed.

The reason, suggestion, or motivation to combine prior art references may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem. The case law of the Court of Appeals for the Federal

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Circuit makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. This is because combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. Therefore, it has been held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed.

Applicant respectfully submits that the Examiner did not apply the correct teaching-suggestion-motivation test for an obviousness rejection under 35 USC 103(a), regarding claim 16. Thus, all rejections in the Office Action dated January 26, 2006 are improper and should be withdrawn.

After comparing the teachings of the art relied upon with claim 16 of the subject application, the Examiner improperly concluded that, at the time of the invention, all of the limitations of claim 16 existed in that art. The Examiner asserted that **Yokouchi** failed to disclose all limitations of claim 16. In particular, the Examiner asserted that **Yokouchi** fails to disclose "a reader for reading the processed image data stored in said memory at a rate of one screen per a second time period which is shorter than the first time period" (Office Action dated January 26, 2006, page 3, last paragraph). Then the Examiner attempted to rely on **Kanai** to remedy the above deficiencies of **Yokouchi**.

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Consequently, after improperly finding a person of ordinary skill in the art would have been motivated to combine **Yokouchi** and **Kanai**, the Examiner rejected claim 16 on obviousness grounds.

The Examiner's analysis applied an incomplete teaching-suggestion-motivation test in the rejection of claim 16. This is because the Examiner rejected claim 16 of the subject application on obviousness grounds without making findings as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of the invention to make the combination in the manner claimed.

The test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.

In this case, neither **Yokouchi** nor **Kanai** address the same problem in the same manner as the invention set forth in claim 16.

In view of the above, Applicant respectfully submits that the rejection of claim 16 should be withdrawn.

Also, it is submitted that the rejection of claims 17 and 21-23 should be withdrawn by virtue of their dependency.

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Claims 18-20 stand rejected under USC 103(a) as obvious over **Yokouchi** in view of **Kanai** and USP 6,295,596 (**Hirabayashi**).

Applicant respectfully traverses this rejection of claims 18-20, for the following reasons.

Hirabayashi fails to remedy the above-described deficiencies of the rejection of claim 16.

Thus, Applicant respectfully submits that the rejection of claims 18-20 should be withdrawn by virtue of their dependency.

Document Number JP08-006528 was submitted to the U.S. Patent and Trademark Office with an Information Disclosure Statement on March 12, 2004. For the Examiner's consideration, an English translation of paragraphs 0011 and 0012 of the Document Number JP08-006528 is as follows:

[0011]

The first change over switch 4 and second change over switch 5 described above are switched in a complementary manner. For example, when the first change over switch 4 inputs display data to the first memory means 2, the second change over switch 5 reads display data stored in the second memory means 3 toward the driver 7. In contrast, when the first change over switch 4 inputs display data to the second memory means 3, the second change over switch 5 reads new display data stored in the first memory means 2 toward the driver 7.

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[0012]

A timing chart to explain the operation is shown in Figure 4. One frame of display data A is stored in the memory means 2 by the first change over switch 4. In the next frame, display data B is stored in the memory means 3. During the time period, the display data A stored in the memory means 2 is repeatedly read out and displayed by four frames at a frequency corresponding to four times of a fetching time period of the one frame of display data. Thus, a frame frequency can be increased even if the LCD panel 8 has a quick response, and therefore, it is possible to carry out a high quality display operation with no perceptible flicker. Then, inputting of the display data by a CPU or the like has no influence by the above described frame frequency, and therefore, one frame of display data can be input in parallel therewith.

In view of the aforementioned remarks, all claims currently pending are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the Applicant's undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, the Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due now or in the future with respect to this application, to Deposit Account No. 01-2340.

Respectfully submitted,
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